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09/634,054	08/08/2000	David A. Newsome, M.D.	P00005US (53783.1P)	4792

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EXAMINER

HAYES, MICHAEL J

ART UNIT PAPER NUMBER

3763

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 15

Application Number: 09/634,054
Filing Date: August 08, 2000
Appellant(s): NEWSOME, M.D., DAVID A.

Seth M. Nehrbass
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/25/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 27-29 and 31.

Claims 30, 34, 35, and 36 are allowed.

Claims 1-26, 32, and 33 have been canceled.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: the question in section (iv) should be: are claims 27-29 and 31 patentable over Beck and applicant's disclosure under 35 USC §103(a)? Claim 31 is currently rejected, claim 30 has been allowed.

(7) *Grouping of Claims*

The rejection of claims 27-29 and 31 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7). Applicant does not give reasons to support his statement that this grouping of claims does not stand or fall together.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 27, 28, 29, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over BECK (U. S. Patent No. 6,319,240) in view of Applicant's disclosure. Beck discloses an apparatus for electrophoresis on an eye including an outer concave/convex shell having an electrode, an inner disposable pre-medicated soft lens with a dilator (8:35-41), and a power source for the electrode. Beck does not disclose the lens is polyfilcon or that the power source is light-activated. It would have been obvious to one of ordinary skill in the art at the time of the invention to use polyfilcon as a design choice since Applicant has not disclosed that polyfilcon solves a stated problem or is for any particular purpose and it appears that a lens made from

another polymer would work equally as well as a pre-medicated reservoir in contact with the eye. Beck does not disclose a light-activated power source; however Applicant discloses that such power sources are well known and commercially available (pg. 7). It would have been obvious to one of ordinary skill in the art at the time of the invention to use a light-activated power source as the power source in the invention of Beck in order to take advantage of well-known benefits of such a power source. The use and interchangeability of various types of power sources would be obvious to the skilled artisan as equivalents.

(11) *Response to Argument*

Applicant argues that the rejection of claim 27 is based on hindsight because applicant disclosed the commercial availability of light-activated power sources. Applicant states that it would not be obvious to use a light-activated power source to provide electricity to a electrophoresis device just because he disclosed its commercial availability.

The examiner points out that merely because Applicant disclosed the commercial availability of light-activated power sources in his application does not make the claimed invention obvious. Rather, Applicant's statement in his disclosure is evidence that it would be obvious to a skilled artisan in the art to use light-activated power sources.

Beck discloses the claimed invention recited in claim 27 except for the light-activated power source. Beck does not explicitly list any particular power sources, but discloses that "various power supplies" may be used with his device (col. 5, lines 24-28). The skilled artisan, after reading Beck's disclosure, must decide on his own what type of power source to use with the prior art electrophoresis device. A skilled artisan would choose a conventional power source to provide the power for the prior art electrophoresis device. The examiner considers

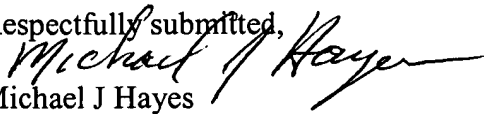
Applicant's disclosure as providing evidence that one of ordinary skill in the art would know that light-activated power sources are available to provide electricity. Applicant's admission makes clear that, at the time of the invention, light-activated power sources were conventional. In addition to providing this evidence of what power source the skilled artisan would know is available at the time of the invention, it appears that the choice of which power source to use is merely a design choice.

Applicant does not give any reason for using a light-activated power source or any suggestion that such a power source solves a particular problem associated with the electrophoresis device. Applicant does not disclose any criticality to using a light-activated power source, and even discloses that the power source could be a battery in one embodiment (pg. 5, line 13). Given the lack of criticality of using a conventional light-activated power source, the examiner concludes that using such a source is merely Applicant's preference; a design choice made by Applicant between the various commercially available power sources. This conclusion is also supported by the prior art, in that Beck also does not consider the type of power source as critical to the invention (col. 5, lines 24-28).

The examiner concludes that a light-activated power source would have been obvious to one of ordinary skill in the art of electrophoresis in view of Applicant's lack of indication that this particular power source solves any stated problem or provides any unexpected result. Therefore the limitation of a light-activated power source does not patentably distinguish over the prior art. See In re Kuhle, 188 USPQ 7, 9 (CCPA 1975).
For the above reasons, it is believed that the rejections should be sustained.

Art Unit: 3763

Respectfully submitted,



Michael J Hayes
Primary Examiner
Art Unit 3763

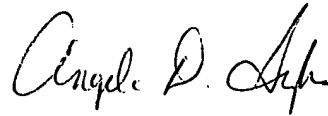
mjh

September 24, 2003

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